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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,393,803	09/10/1999	MARGARET A. LIU	19188PCA	3309

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MERCK AND CO INC
P O BOX 2000
RAHWAY, NJ 070650907

EXAMINER

LEFFERS JR, GERALD G

ART UNIT PAPER NUMBER

1636

DATE MAILED: 11/26/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/393,803

Applicant(s)

LIU ET AL.

Examiner

Gerald G Leffers Jr.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-22,25,39-41,44,45,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-11, 13-22,25,39-41,44,45, and 49 is/are allowed.
- 6) ☒ Claim(s) 12 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of applicants' amendment, filed 11/5/02 as Paper No. 15. This amendment has been entered into the file and has resolved the remaining issues from the previous office action. However, upon further review of the pending claims additional issues have arisen that require remediation prior to the claims being issued. For these reasons, prosecution of this application is hereby reopened.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are vague and indefinite in that they comprise the limitation that "...the first cistron encodes a REV-independent human immunodeficiency (HIV) epitope,wherein the first, second and third cistron may be presented in any combination..." while claim 1, upon which these claims are dependent, specifies that the first cistron necessarily encodes at least one HIV epitope. These limitations are not compatible and it would be remedial to amend these claims to remove this incompatibility.

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Drawings

While it is acknowledged that applicants have submitted proposed changes to drawings in the paper filed 10/27/00 as Paper No. 7. The proposed changes were accepted by the examiner in Paper No. 8, mailed 1/17/01. The corrected drawings have not been received. Further, applicants are reminded of the objections to all of the drawings made by the draftsman in the PTO Form 948 mailed with Paper No. 5 on 4/24/00.

New Claims

It is respectfully requested that applicants resubmit the pending claims as new claims numbering from claim 50 for the following reasons. While it is understood that the examiner requested a new, clean copy of the pending claims in Paper No. 5, the submission of replacement pages in Paper No. 7 has actually complicated the entry of subsequent amendments to the claims. While the examiner has a clear understanding of those claims that are pending and allowable, confusion may arise during the process of printing as to which versions of the claims in the file are to be printed. Therefore, it would be helpful to cancel the pending claims and resubmit them as they are currently worded as new claims beginning with claim 50. If the applicant has any questions with regard to this issue, the examiner can be contacted at the number listed below.

Conclusion

Claims 12 and 48 are rejected. Claims 1, 5-11, 13-22, 25, 39-41, 44-45 and 49 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr. whose telephone number is (703) 308-6232.

The examiner can normally be reached on 9:30am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7939 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Gerald G Leffers Jr.
Examiner
Art Unit 1636

Ggl

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November 24, 2002

DAVID GIZO
PRIMARY EXAMINER
David Gizo